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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,740	02/22/2002	Irwin Kotovsky	KOTOV-14	8291

7590 10/03/2003
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EXAMINER

CARIASO, ALAN B

ART UNIT PAPER NUMBER

2875

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,740

Applicant(s)

KOTOVSKY, IRWIN

Examiner

Alan Cariaso

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Applicant's Response

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the opening of the metal heat plate through which the lamp socket extends (claim 12) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 12, the phrase "a metal heat plate disposed adjacent the housing top having an opening through which the socket extends" is indefinite as being misdescriptive. The specification does not disclose any opening on the metal heat plate 40 through which any of the socket(s) 38 extend.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by SCHAFER (US 5,117,340).

7. In regards to claims 1-4, SCHAFER discloses a means for lighting (figs.1-3) including at least one lamp (14,25 or 58,59,66) and one transformer (17 or 52) electrically connected to the lamp, the lamp being either a low voltage or a line voltage (21 or 42) lamp; a housing (13 or 53) for holding the lamp, the housing (13 or 53) having an outer surface made of wood, plastic, glass, marble or synthetic (col.2, lines 52-54); wherein the housing (13 or 53) includes an interior (hollow interior-col.2, lines 24-27 or solid interior col.2, lines 50-52), and an outer layer (coating) positioned about the interior, the outer layer essentially being or having the outer surface, the outer layer made of wood, plastic, glass, marble or synthetic (col.2, lines 24-27 or lines 52-54); the housing (31 or 53) has a rectangular shape (col.2, line 12-15); the lighting means includes at least a second lamp (14,25 or 58,59,66).

8. In regards to claims 15 and 16, SCHAFER discloses attaching a housing (support plate 13 or 53, figs.1-3) having an interior made of metal or plastic (col.2, lines 50-52) and an outer layer made of wood (col.2, lines 52-54) to a ceiling (10); and

Art Unit: 2875

introducing a low voltage or a line voltage lamp (14,25 or 58,59,66) into a lamp socket (65,56,57) connected to a transformer (17 or 52) adjacent the housing (13 or 53).

9. Claims 1, 2, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by STAFFORD et al (US 5,911,499).

10. STAFFORD discloses a means for lighting (10-figs.1-2) including at least one lamp (52) and one transformer (88-fig.2) electrically connected to the lamp, the lamp (52) being either a low voltage or a line voltage lamp (fig.7); a housing (20 or 40) for holding the lamp (52), the housing (40) having an outer surface made of wood, plastic, glass, marble or synthetic (col.5, lines 20-22; col.4, lines 63-67); wherein the housing (20 or 40) includes an interior (space-fig.2 or unit 16-fig.1), and an outer layer (20 or 40) positioned about the interior, the outer layer essentially being or having the outer surface, the outer layer made of wood, plastic, glass, marble or synthetic (col.4, lines 63-67; col.5, lines 20-22); wherein a lighting apparatus (10) is formed by placing an outer layer (20, 40) about an interior (interior space or unit 16) of a housing (40); attaching the housing (20,40) to a ceiling (col.4, lines 1-7); introducing a lamp socket (52) connected to a transformer (88) adjacent the housing (20, 40) for either a low voltage or a line voltage lamp.

11. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by USHER (US 4,751,627).

Art Unit: 2875

12. USHER discloses a lighting apparatus that is formed by placing an outer layer (232) about an interior (interior space, figs.11-13) of a housing (232); introducing a lamp socket (50-fig.2) connected to a transformer (272) adjacent the housing (232) for either a low voltage or a line voltage lamp (30, col.2, lines 65-68 and col.6, lines 44-54).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over STAFFORD et al (US 5,911,499).

15. STAFFORD discloses applicant's claimed invention as recited in claims 4-6 and 8-14 including: at least a second lamp (52); a gimbal ring assembly (76) with yoke (64) holding the lamp(s) (52); the outer layer or housing (40-fig.1) being formed by plates (12,22,40-fig.1) that are at least protruding with respect to the housing circumference and the plates being fixed; the housing being surface mounted from the ceiling or wall mounted (col.4, lines 1-7); a metal plate (62-fig.1; col.5, line 64) disposed adjacent the housing top (42) having an opening (col.5, line 65 to col.6, line 2) through which at least the lamp holder fastener and wire conduit extends, the metal plate inherently conducting heat; and the transformer (88) being integral and attached or detached (figs.1-2) to the housing (40,42).

16. However, STAFFORD does not disclose the rectangular shape of the housing of claim 3, including corners that are mitered, butted, or overlapped of claim 7. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shape of the light fixture housing of STAFFORD to include a rectangular shape with corners, since it has been held that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination. See *in re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966), where the court held that the configuration of the claimed container was found obvious absent persuasive evidence that the particular configuration of the claimed container was significant. Further, one would have been motivated to select the shape of a rectangle with corners with respect to the housing in order to facilitate fitting the plural rectangular interior components (fig.4) inside the housing.

Response to Arguments

17. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

18. In regards to the drawing objection and rejection of claims 12-14 for being indefinite or misdescriptive, emphasis is made regarding the opening of the metal heat plate through which the sockets extends, which currently is not illustrated and nor supported in the written disclosure.

Art Unit: 2875

19. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

20. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. CLEMENT (US 5,203,626) shows light fixture housing (1-fig.1) made of metal or plastic (col.4, line 13) holding line voltage lamps (fig.2) connected to a remote transformer (12) providing low volt power (col.4, lines 61-65). WEINSTOCK et al (US 5,426,572) show a rectangular housing (11,21) made of sheet metal or plastic (col.2, lines 61-64) holding socket-lamp assemblies (55) and an attached or detached


Art Unit: 2875

transformer (105-figs.2 & 5). MARGULIES et al (US 5,848,833) show a lamp housing that hold lamp assemblies for room illumination that comprise multiple removable and fixed plates (fig.3). SCHMITT (US 4,748,545) shows exterior and interior housing elements comprising any of metal liner 22, thermal insulation being air (col.4, lines 54-55) or solid 118 holding plural low voltage line voltage lamps connected to an adjacent transformer (54).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (703) 308-1952. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Alan Cariaso
Primary Examiner
Art Unit 2875

AC
September 15, 2003